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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,805	06/13/2005	Raymond Puffer	12834-00009-US	1169
23416 7590 04/01/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
CANTELMO, GREGG				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,805

**Applicant(s)**

PUFFER ET AL.

**Examiner**

Gregg Cantelmo

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 15-30, 32, 33 and 35-60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☒ Claim(s) 14 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/25/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group II, Species a (claims 14, 31 and 34) in the reply filed on February 5, 2009 is acknowledged. The traversal is on the ground(s) that the subject matter in each of these groups are closely related, similar issues of patentability are presented in each of these groups, the fields of search are similar and overlapping and similar issues must be addressed in determining the patentability of the subject matter of each group. This is not found persuasive.

First basis for restriction, in accordance with 371 applications fails to establish a common special technical feature. For example, the international search report (ISR) for the corresponding international priority document establishes a lack of special technical feature to all claims as evidenced by the X citation to various claims. Thus all of the claims do not share a common special technical feature and do not share similar issues of patentability in each of these groups and do not share similar issues in determining the patentability of the subject matter of each group.

As to the nature of the fields of search, as set forth in the prior restriction each group and species pertain to particular special features which are not identical in scope with one another. Thus the fields of search are not held to be similar and coextensive in scope.

Regarding the argument that the inventions are closely related is not persuasive since the standard for establishing unity of invention is not a subjective close relation but whether each invention shares the same special technical features. As set forth in

the prior restriction and as further evidenced by the ISR which anticipates some of the claims in the corresponding international priority document a lack of a common special technical feature between all of the claims is evident and restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

***Response to Preliminary Amendment***

2. The preliminary amendment filed February 25, 2005 has been entered.

***Response to Amendment filed in response to the Restriction***

3. The claim amendment filed February 5, 2009 has been entered. Claims 1-60 (as renumbered) are pending. With claims 1-13, 15-30, 32, 33 and 35-60 withdrawn from consideration as to non-elected inventions. Action on the merits of claims 14 , 31 and 34 follows.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

5. The information disclosure statement filed February 25, 2005 has been placed in the application file and the information referred to therein has been considered as to the merits.

***Drawings***

6. The drawings received February 25, 2005 are acceptable for examination purposes.

***Claim Objections***

7. Claims 14 and 31 objected to because of the following informalities: claims 14 and 31 are now dependent upon withdrawn claims. Applicant is advised to amend these claims into independent form to overcome this objection. Appropriate correction is required.

8. Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The particular membrane recited in claim 31, does not further define the apparatus for transferring the membrane since the membrane is not a required component of the transfer apparatus but is merely an article manipulated by the apparatus. See MPEP 2115, incorporated herein.

***Claim Interpretation - 35 USC § 112***

9. Applicant employs "means for" language in claim 31 which may intend to invoke 35 USC § 112 – 6<sup>th</sup> paragraph. If Applicant maintains the use of the language "means for" in the claim, this will be interpreted as an intend to invoke 35 USC § 112 – 6<sup>th</sup> paragraph. If Applicant does not intend to invoke this section of 35 USC § 112, Applicant is advised to remove the term "means for" from the claim. Currently it is unclear as to whether 35 USC § 112 – 6<sup>th</sup> paragraph is invoked since dependent claims to claim 15 (which is encompassed in elected claim 31) recite specific structure to the various means of claim 15. By reciting specific structure to the various means, the dependent claims do not comply with 35 USC § 112 – 6<sup>th</sup> paragraph. Clarification is respectfully requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,165,306 (Rajala).

Rajala discloses of an apparatus for transferring a thin film from a source position 212 to a target position, the apparatus comprising: means for transferring the thin film from the source position to a first surface in a first position on roller 404; means for rotating the roller 404 so that the first surface wherein the thin film is rotated to a second position and transferred from the first surface of roller 404 to a second surface of roller 150, the second surface 150 is rotated from to a second position; and the film is then transferred from the second roller 150 to the target position on carrier 222 (Fig. 4 as applied to claim 31).

Regarding the particulars of the membrane of claim 31 being a fuel cell membrane, this aspect is not a requisite feature of the transferring apparatus but merely constitutes the article manipulated by the apparatus. As such, no patentable weight is given to the article of claim 31 (being a fuel cell membrane).

According to MPEP 2115:

## **MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS**

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In *In re Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Therefore the particular membrane of claim 31 is not held to further limit the apparatus of the claim.

11. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,726,876 (Tomsovic).

Tomsovic discloses of an apparatus for transferring a thin film from a source position 18 to a target position on roller 40, the apparatus comprising: means for transferring the thin film from the source position to a first surface in a first position on rotating transfer device 20; means for rotating the transfer device 20 so that the first

surface wherein the thin film is rotated to a second position and transferred from the first surface of transfer device 20 to a second surface of a second transfer device 30, the second surface of second transfer device 30 is rotated from to a second position; and the film is then transferred from the second transfer device 30 to the target position on carrier 40 (Figs. 1 and 2 as applied to claim 31).

Regarding the particulars of the membrane of claim 31 being a fuel cell membrane, this aspect is not a requisite feature of the transferring apparatus but merely constitutes the article manipulated by the apparatus. As such, no patentable weight is given to the article of claim 31 (being a fuel cell membrane).

According to MPEP 2115:

## **MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS**

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of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Therefore the particular membrane of claim 31 is not held to further limit the apparatus of the claim.

***Allowable Subject Matter***

12. Claim 34 is allowed.

The following is an examiner's statement of reasons for allowance: none of the prior art of record are held to reasonably teach, suggest or obviate the method for feeding a fuel cell membrane as recited in claim 34.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. Claim 14 is objected to as being dependent upon a withdrawn base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record are held to reasonably teach, suggest or obviate the method for transferring a thin film wherein the process employs a fuel-cell membrane as the thin film as recited in claim 14.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Cantelmo/  
Primary Examiner, Art Unit 1795